

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/882,415	06/25/97	ZHANG	S MIT-7762

HM42/0208

HAMILTON BROOK SMITH & REYNOLDS
TWO MILITIA DRIVE
LEXINGTON MA 02173-4799

EXAMINER

GARCIA, M

ART UNIT

PAPER NUMBER

1627

17

DATE MAILED: 02/08/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Interview Summary	Application No. 08/882,415	Applicant(s) Zhang et al
	Examiner Maurie E. Garcia, Ph. D.	Group Art Unit 1627

All participants (applicant, applicant's representative, PTO personnel):

(1) Maurie E. Garcia, Ph. D. *M/G*

(3) Mr. David Brook

(2) SPE Donald Adams, Ph.D., J.D.

(4) Ms. Theresa Devlin

Date of Interview Feb 2, 2000

Type: Telephonic Personal (copy is given to applicant applicant's representative).

Exhibit shown or demonstration conducted: Yes No. If yes, brief description:

Agreement was reached. was not reached.

Claim(s) discussed: N/A

Identification of prior art discussed:

Wang et al reference.

Description of the general nature of what was agreed to if an agreement was reached, or any other comments:

See attached.

(A fuller description, if necessary, and a copy of the amendments, if available, which the examiner agreed would render the claims allowable must be attached. Also, where no copy of the amendments which would render the claims allowable is available, a summary thereof must be attached.)

1. It is not necessary for applicant to provide a separate record of the substance of the interview.

Unless the paragraph above has been checked to indicate to the contrary, A FORMAL WRITTEN RESPONSE TO THE LAST OFFICE ACTION IS NOT WAIVED AND MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a response to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW.

2. Since the Examiner's interview summary above (including any attachments) reflects a complete response to each of the objections, rejections and requirements that may be present in the last Office action, and since the claims are now allowable, this completed form is considered to fulfill the response requirements of the last Office action. Applicant is not relieved from providing a separate record of the interview unless box 1 above is also checked.

Examiner Note: You must sign and stamp this form unless it is an attachment to a signed Office action.

Interview Summary – Attachment

Discussed the prior art (Wang et al) that has been applied throughout prosecution with respect to the term “predetermined pattern”. Stated that “predetermined” was ambiguous and that the specification stated with respect to applicants definition thereof that the “patterns which can be selected in this invention are not particularly critical” (page 12, lines 28-29). Applicant argued the definition of the term “predetermined” as it has been used in other issued patents; however, whether similar claims have been allowed in other cases is immaterial. See, *Ex parte Balzarini* 21 USPQ 2d 1892 BPAI (1991) citing *In re Giolito*, 530 F.2d 397, 188 USPQ 645 (1976). It was therefore stated that issues remain regarding the term “predetermined pattern”.

Furthermore, the suggestion to amend the claims made during the Telephonic Interview of August 4, 1999 was not an indication of allowable subject matter. Additionally, it was stated that applicant appears to have agreed with the Office’s position regarding “predetermined pattern” since Applicant attempted to amend their claims After Final to clarify the term. Unfortunately, this amendment introduced other issues as described in the Advisory Action mailed December 2, 1999 and could not be entered. Moreover, there was no reason that such an amendment was not earlier presented.

At this point, Applicant moved their argument to the terminology “directly attached” stating that Wang’s peptides are not directly attached to the substrate as defined in Applicants specification. However, the examiners stated that it was their understanding that the issue for discussion was the term “predetermined pattern”, since

this had been the point of discussion in the previous Interview (with Examiners Achutamurthy and Garcia) and was the subject of the proposed After Final amendment.

Since the examiners were not prepared to discuss this second issue at the time of this interview, we stated that Dr. Garcia would contact applicants again. Dr. Garcia called Mr. Brook later in the day on February 2, 2000 to discuss this issue. Since Mr. Brook was not available, she left a voice mail message briefly stating that further consideration of the terminology as it applies to the Wang et al reference, as requested by applicants, was not persuasive to change the decision of the examiners to maintain finality and non-entry of the After Final amendment.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurie E. Garcia, Ph.D. whose telephone number is (703) 308-0065. The examiner can normally be reached on Monday-Thursday from 8:30 to 6:00 and on alternate Fridays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald E. Adams, Ph.D., can be reached on (703) 308-0570.

Maurie E. Garcia, Ph.D.
February 2, 2000